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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,745	12/10/2001	Kathleen R. McKeown	A32313-PCT	3754

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EXAMINER	
CORRIELUS, JEAN M	

ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/913,745	MCKEOWN ET AL.	
	Examiner	Art Unit	
	Jean M Corrielus	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *1/21/05*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to the Appeal Brief filed on January 21, 2005, in which claims 1-22 are presented for further examination.

Response to Arguments

2. In view of the Appeal Brief filed on January 21, 2005, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 8 recite "focus elements", "phrase intersection", "phrase intersection table" and "temporal processing". It is not clear how one having ordinary skill in the art would understand what the Applicant meant by "focus elements" without elaborating such limitation in the claim. The terms "phrase intersection" and "phrase intersection table" are not understood to one having ordinary skill in the art to make and use the invention. It is not clear as to what "phrase intersection" and "phrase intersection table" the Applicant is referring to. Further, it is unclear how one having ordinary skill in the art would perform a temporal processing on a phrase without having any knowledge of what the Applicant is referring to "temporal processing". Applicant is advised to amend the claims to elaborate the abovementioned limitations in the claims in order to clarify any confusion from the examiner.

Claims 2, 4, 9, 11, 17 and 19 recite "paraphrasing rules". It is unclear as to which rules the applicant is referring to. Applicant is advised to amend the claim to detail the aforementioned limitation to clarify any confusion from the examiner.

Claims 5, 12 and 20 recite "ambiguous temporal references", "temporal marker" and "temporal gap". It is not clear as to which ambiguous temporal references, temporal marker and temporal gap the Applicant refers to. There is no detail explanation as to what those limitations are meant in the claim.

Claims 6, 13 and 21 recite, "phrase divergence processing". It is not clear as to which phrase divergence the Applicant refers to. There is no detail explanation as to what those limitations are meant in the claim.

Claims 1, 8 and 16 recite the use of "generating a summary of a plurality of related documents". However, the body of the claim does not provide the use of generating a summary of related documents. The body does not perform what set forth in the preamble. There is no connection between the preamble and the body of the claim. Applicant is advised to amend the claims to connect the body of the claim with the preamble of the claim.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, specifically, as directed to an abstract idea.

Claims 1-7 in view of **MPEP section 2106 IV.B.2. (b)** define non-statutory processes because they merely manipulate an abstract idea without a claimed limitation to a practical application. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. The invention, as claimed, is directed to the manipulation of an abstract idea with no practical application in the technology arts. Thus, the

claimed are rejected as being non-statutory.

The Supreme Court has repeatedly held that abstractions are not patentable. "An idea of itself is not patentable". Rubber-Tip Pencil Co. V. Howard, 20 wall. 498, 07. Phenomena of nature, though just discovered, mental processes, abstract intellectual concepts are not patentable, as they are the basis tolls of scientific and technological work Gottschalk V. Benson, 175 USPQ 673, 675 (S Ct 1972). It is a common place that laws of nature, physical phenomena, and abstract ideas are not patentable subject matter Parker V. Flook, 197 USPQ 193, 201 (S Ct 1978). A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See In re Wamerdam, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1754, 1759 (Fed. Cir. 1994). See also Schrader, 22 F.3d at 295, 30 USPQ2d at 1459.

Claim 1 represents an abstract idea, which do not provide a practical application in the technological arts. There is no manipulation of data nor there is any transformation of data from one state to another being performed in "A method for generating a summary of a plurality of related documents" in claim 1. Actually, no post computer process activity is found in the technological arts. The method for generating a summary of a plurality of related documents is not a physical transformation. Thus, no physical transformation is performed, no practical application is found in the claims. Such determining a match as claimed can be done in a piece of paper, where one having ordinary skill in the art would build a graph that links the entity to a portion of the concept to produce the description of the audiovisual information in the sheet. Also, the claims do not appear to correspond to a specific machine or manufacture disclosed within the specification and thus encompass any product of the class configured in any manner to perform the underlying process, and are thus rejected as being directed. Claim 1 is not **tangibly**

embodied in a manner so as to be executable as the only hardware is in an intended use statement. Therefore, claim 1 is directed to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Applicant is advised to amend the claims by specifying the claim being directed to a practical application and producing a tangible result being executed by a general-purpose computer in order to correct the above indicated deficiencies.

The dependent claims 2-7 are rejected for fully incorporating the errors of their respective base claims by dependency. Thus, claim 2-7 are merely abstract idea and are being processed without any links to a practical result in the technology arts and without computer manipulation. They are not **tangibly embodied** in a manner so as to be executable as the only hardware is in an intended use statement.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-22 as best understood by examiner are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakao US Patent no. 6,205,456 and Razin et al., (hereinafter "Razin") US Patent no. 6,098,034.

As to claim 1, Razin discloses the claimed "extracting phrases having focus elements from the plurality of documents" as extracting phrases in a document to automatically create a list of

extracted phrases (col.2, lines 45-56; col.30, lines 53-54); "performing phrase intersection analysis on the extracted phrases to generate a phrase intersection table" determining which phrases that are identical (col.2, lines 56-64); "performing temporal processing on the phrases in the phrase intersection table" (col.3, lines 24-30, lines 46-58; col.4, lines 4-17); and "performing sentence generation using the phrases in the phrase intersection table" constructing sentence from the determination of standard phrases (col.3, lines 35-38). However, Razin does not explicitly disclose the use of generating a summary of documents. On the other hand, Nakao discloses a system for generating a summary of a document based on an extraction result from a focused information (col.5, lines 64-67; col.6, lines 14-17); and "extracting phrases having focus elements from the plurality of documents" extracting a phrase in the document based on the condition of the pattern or the extracting sentences (col. Lines 57-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of the cited references, wherein the master phrase finding phrase, provided therein (see Razin's fig. 2) would incorporate the use of generating a summary of the documents based on the user preference. One having ordinary skill in the art at would found it motivated to utilize such a combination in order to ensure the syntactic coherence of the document.

As to claim 2, Razin discloses the claimed "representing the phrases in tree structures having root nodes and children nodes" (col.5, lines 18-30; col.10, lines 45-63; col.15, lines 5-20; col.16, lines 5-50); "selecting those tree structures with verb root nodes" (col.7, lines 55-60; col.10, lines 45-63; col.15, lines 5-20; col.16, lines 5-50); "comparing the selected root nodes to the other root

nodes to identify identical nodes" (col.8, lines 18-30; col.10, lines 45-63; col.12, lines 33-50; col.23, lines 17-27); "identifying candidate phrases of the document which are similar" (col.20, lines 32-46; col.21, lines 20-36, lines 45-55); "applying paraphrasing rules to non-identical root nodes to determine if non identical nodes are equivalent" (col.15, lines 5-20; col.16, lines 5-50; col.23, lines 43-56; col.24, lines 4-11; col.1, lines 42-53); and "evaluating the children nodes of those tree structures where the parent nodes are identical or equivalent" (col.15, lines 5-20; col.16, lines 5-50; col.23, lines 43-56; col.24, lines 4-11).

As to claim 3, Razin discloses the claimed "wherein the tree structure is a DSYNT tree structure" (col.5, lines 18-30; col.10, lines 45-63; col.15, lines 5-20; col.16, lines 5-50).

As to claim 4, Razin discloses "wherein the paraphrasing rules are selected from the group consisting of ordering of sentence components, main clause versus a relative clause, different syntactic categories, change in grammatical features, omission of an empty head, transformation of one part of speech to another and semantically related words" (col.7, lines 54-65; and col.25, lines 20-45).

As to claim 5, Razin discloses the claimed "wherein the temporal processing includes time stamping phrases based on a first occurrence of the phrase in the collection" (col.15, lines 5-20; col.16, lines 5-50; col.23, lines 43-56; col.24, lines 4-11; col.1, lines 42-53); "substituting date certain references for ambiguous temporal references" (col.15, lines 5-20; col.16, lines 5-50; col.23, lines 43-56; col.24, lines 4-11; col.1, lines 42-53); "ordering the phrases based on the

time stamp" (col.); and "inserting a temporal marker if a temporal gap between phrases exceeds a threshold value" (col.2, lines 4-13; col.7, lines 4-11; col.16, lines 5-17, lines 25-32; col.23, lines 50-56).

As to claim 6, Razin discloses the claimed "a phrase divergence processing operation" (col.15, lines 5-20; col.16, lines 5-50; col.23, lines 43-56; col.24, lines 4-11; col.1, lines 42-53).

As to claim 7, Razin discloses the claimed "wherein the sentence generation includes mapping phrases to an input format of a language generation engine and operating the language generation engine" (col.2, lines 56-64).

As to claims 8-15:

Claims 8-15 are the system claimed for performing the method of claims 1-7. They are rejected under the same rationale. In addition, Razin discloses the claimed "a storage device for storing the documents in the collection, wherein the storage device for storing the documents in the collection is remotely located from the processing subsystem" (col.1, lines 55-col.2, line 14); "a lexical database" (col.6, lines 30-36; col.7, lines 30-35; col.25, lines 20-45); and "a processing subsystem, the processing subsystem being operatively coupled to the storage device and the lexical database, the processing subsystem being programmed to access the documents in the storage device" (col.6, lines 30-36; col.7, lines 30-35; col.25, lines 20-45).

As to claims 16-22:

Claims 16-22 are computer readable media for programming a computer system to perform the method of claims 1-7. They are, therefore, rejected under the same rationale.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jean M Corrielus
Primary Examiner
Art Unit 2162

May 24, 2005